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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,041	12/01/2003	Martin Leiendecker	A 91874	1537
7590	05/03/2005			
Walter Ottesen Patent Attorney P.O. Box 4026 Gaithersburg, MD 20885-4026			EXAMINER CADUGAN, ERICA E	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,041

Applicant(s)

LEIENDECKER, MARTIN

Examiner

Erica E Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/1/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,971,678 to Linderholm, for example.

Linderholm teaches a tool holder 22 that holds a tool 24, and that is driven in rotation by spindle motor 12 about tool rotation axis 26 (see Figure 1). Additionally, the tool is moved transversely with respect to this tool rotation axis to enable the tool to perform cutting of openings that are larger in size than the diameter of the tool itself. (Thus, the tool inherently has both end or face cutting edges and peripheral cutting edges, or else it would not be able to cut such an opening as described). See col. 6, lines 7-65, col. 7, lines 15-29, and especially col. 7, lines 43-51.

Re claims 4-6, Linderholm explicitly teaches that the spindle motor 12 can be powered electrically, pneumatically, or hydraulically (col. 4, lines 60-62).

Re claim 9, note that the tool holder 22 is connected to the drive spindle including spindle motor 12 of the machine tool as described previously.

Re claim 7, as broadly claimed, note that an assembly including the cutting tool 24, the tool holder 22, and the spindle motor 12 is moved transversely, such as in direction 74 (Figure 2), relative to fixed mounting plate 90, for example (see also Figure 4 and Figure 2, and see col.

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6, lines 7-65, col. 7, lines 15-29 and col. 7, lines 43-51). Thus, with respect to claim 7, note that the assembly including the tool 24 and spindle motor 12 form part of a “tool head”, and that thus, the cutting tool 24 is “part” of a “tool head” that is “connectable” to the “tool holder” 22.

Re claim 8, note also that the just-described “tool head” includes the spindle motor 12, which Linderholm explicitly teaches can be powered pneumatically (col. 4, lines 60-62).

Re the use of the claimed “arrangement” being “for forming a control window in a cylinder housing for a two-stroke internal combustion engine...”, it is noted that in an apparatus claim, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the instant case, since Linderholm explicitly teaches that the device is utilized to machine openings in workpieces, it is considered capable of cutting a “control window” as claimed.

Additionally note that “[i]nclusion of material or article worked on by a structure being claimed does not impart patentability to the claims.” *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See also MPEP section 2115. In other words, the apparatus is blind as to the workpiece on which it operates (i.e., the tool doesn’t care if it’s working on a two-stroke engine, or on a cube-shaped workpiece blank).

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Linderholm as applied to claims 1 and 9 above.

Linderholm teaches all aspects of the present invention as set forth in the above rejection based thereon. Additionally, since the toolholder is fixedly connected for rotation to the spindle motor, it appears that the toolholder is, as broadly claimed, "part" of the drive spindle.

In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the toolholder integral with the spindle, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893), for example.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note especially that U.S. Pat. No. 6,474,914 to Lang teaches an additional pneumatically motorized attachment for holding a cutting tool, the attachment being driveable by a spindle of a machine tool.

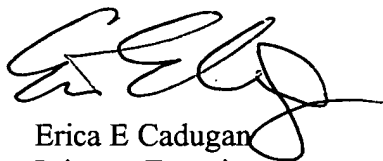
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E Cadugan whose telephone number is (571) 272-4474.

The examiner can normally be reached on M-F, 7:30 a.m. to 5:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'EEC', with a stylized flourish extending from the end.

Erica E Cadugan
Primary Examiner
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eec

April 28, 2005